

Appl. No. : 09/814,547
Filed : March 22, 2001

REMARKS

A. Introduction

The remarks herein are responsive to the Office Action dated November 30, 2005. Claims 1-22 are pending in this application. Claims 1-22 stand rejected. Applicants have amended Claim 14. The Applicants respectfully submit the claims are in condition for allowance.

B. Amendments to the Claims

Claim 14 has been amended to more clearly define that Section 501(c)(3) refers to the Internal Revenue Code of 2001, which is the year of the application filing date.

C. Claim Rejections Under 35 U.S.C. § 112

Claim 14 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the invention.

Dependent Claim 14 has been amended to more clearly define that Section 501(c)(3) refers to the Internal Revenue Code of 2001. Applicants respectfully submit that the scope of Claim 14 will not change over time, and therefore Claim 14 is in condition for allowance for at least the reasons described above.

D. Claim Rejections Under 35 U.S.C. § 103

1. Claims 1-3, 10, 17, 18, 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,330,547 to Martin in view of U.S. Patent Application Publication No. 2002/0099637 to Wilkinson et al.

Applicants respectfully submit that Martin does not teach or suggest *inter alia* an investment risk minimization system involving a venture capital investor and a venture needing *investment* from the venture capital investor as claimed in Claim 1. Instead, Martin teaches a method and apparatus for deciding whether to make a *loan* using an intangible asset, such as intellectual property, as *collateral* and for making such a *loan* more attractive to a *lender*. See Abstract. Further, Martin teaches that a venture capital *investment* by a venture capitalist is distinct and separate from a *loan* made by a lender. Martin states that venture capital financing results in dilution of ownership of a company whereas debt financing does not result in a loss of ownership control. See col. 1, ln. 35-43. As acknowledged by the Examiner, Martin does not disclose transferring the intellectual property asset to a charitable organization. Therefore,

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Applicants respectfully submit Martin fails to teach all the limitations of Claim 1, and thus, Claim 1 is allowable for at least the reasons cited above. Claims 2-9 depend, either directly or indirectly, from Claim 1, and are therefore allowable for at least the reasons cited above. Further, Claims 2-9 are also allowable for the additional unique combination of features disclosed therein.

Further, Applicants respectfully submit that Wilkinson does not teach or suggest *inter alia* securing an ownership right to an intellectual asset upon failure by a venture to meet *established parameters* and valuing the intellectual asset and transferring the intellectual asset to a charitable organization. Instead, Wilkinson teaches a process for investment in intellectual property, comprising providing an accounting for an intellectual property investment; providing a valuation with respect to the intellectual property investment; performing financial analysis related to the intellectual property investment and making a recommendation based upon the financial analysis; and managing the investment based upon the accounting, valuation, and analysis for the investment. See Abstract. Nowhere does Wilkinson suggest that the disclosed process for investment comprises obtaining ownership in the intellectual asset if the venture receiving the investment fails to meet established parameters. Therefore, Applicants respectfully submit Wilkinson fails to teach all the limitations of Claim 1, and thus, Claim 1 is allowable for at least the reasons cited above. Claims 2-9 depend, either directly or indirectly, from Claim 1, and are therefore allowable for at least the reasons cited above. Further, Claims 2-9 are also allowable for the additional unique combination of features disclosed therein.

A *prima facie* rejection for obviousness requires: (1) a disclosure or suggestion of every element of the claim in the cited reference or references; (2) a suggestion or motivation to modify or combine the references; and (3) a reasonable expectation of success. The suggestion to combine and the reasonable expectation of success must be found in the prior art or known to one skilled in the art. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that there is no suggestion or motivation to combine the cited references. There is no indication that the process for *investment* in intellectual property disclosed by Wilkinson would be suitably combined with the method for deciding whether to make a *loan* disclosed by Martin. There is no suggestion to combine if a reference teaches away from its combination with another source. *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 U.S.P.Q. 2d 1294 (Fed. Cir. 1999). Applicants respectfully submit that Martin

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distinguishes a *loan* from an *investment*, such that the method and apparatus disclosed by Martin is adapted for making a loan and not an investment. Further, there is no reasonable expectation of success to combine these references for the simple reason that Martin teaches that a venture capital investment by a venture capitalist is distinct and separate from a loan made by a lender. Even if Martin and Wilkinson were combined, the combined references fail to disclose all the features claimed in Claim 1 as set forth above. Therefore, Applicants respectfully submit Martin fails to teach all the limitations of Claim 1, and thus, Claim 1 is allowable for at least the reasons cited above. Claims 2-9 depend, either directly or indirectly, from Claim 1, and are therefore allowable for at least the reasons cited above. Further, Claims 2-9 are also allowable for the additional unique combination of features disclosed therein.

Applicants respectfully submit that Martin in view of Wilkinson do not make obvious Claim 10 for at least the reasons cited above. Furthermore, Claims 11-16 depend, either directly or indirectly, from Claim 10, and therefore Applicants respectfully submit that these claims are allowable for the same reasons as discussed above for Claim 10. Further, claims 11-16 are also allowable for the additional unique combination of features disclosed therein.

Applicants respectfully submit that Martin in view of Wilkinson do not make obvious Claim 17 for at least the reasons cited above. Furthermore, Claims 18-22 depend directly from Claim 17, and therefore Applicants respectfully submit that these claims are allowable for the same reasons as discussed above for Claim 17. Further, claims 18-22 are also allowable for the additional unique combination of features disclosed therein.

2. Claims 4, 6, 8, 11-13, 15, 16 and 19 are rejected as being obvious because the Examiner alleges that these features are "old and well-known practices in the art of financial lending."

Applicants respectfully submit that Claims 4, 6, 8, 11-13, 15, 16 and 19 are allowable for at least the reasons set forth above. Further, and as explained above, there are three requirements for establishing a prima facie rejection for obviousness. Applicants respectfully submit that Martin, as acknowledged by the Examiner, fails to teach the features of Claims 4, 6, 8, 11-13, 15, 16 and 19. Moreover, it is respectfully noted that the Examiner has provided no references disclosing the missing elements from Martin. Therefore, there can be no suggestion or motivation to modify or combine Martin with other references. Lastly, without such a suggestion

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or motivation, there can be no reasonable expectation of success. Thus, Applicants submit that the Examiner has not established an adequate prima facie rejection for obviousness, therefore, respectfully submit that Claims 4, 6, 8, 11-13, 15, 16 and 19 are allowable at least for the reasons cited above.

3. Claim 5 is rejected as being obvious, however, Applicants respectfully submit that Claim 5 directly depends from Claim 1. Further, Applicants respectfully submit, as set forth above, that Claim 1 is allowable, and thus Claim 5 is also allowable for at least the same reasons cited above for independent Claim 1.

4. Claim 7 is rejected as being obvious, however, Applicants respectfully submit that Claim 7 directly depends from Claim 1. Further, Applicants respectfully submit, as set forth above, that Claim 1 is allowable, and thus Claim 7 is also allowable for at least the same reasons cited above for independent Claim 1.

5. Claim 9 is rejected as being obvious, however, Applicants respectfully submit that Claim 9 directly depends from Claim 1. Further, Applicants respectfully submit, as set forth above, that Claim 1 is allowable, and thus Claim 9 is also allowable for at least the same reasons cited above for independent Claim 1.

E. Conclusion

For the reasons respectfully presented above, Applicants submit that this application, as amended, is in condition for allowance. If there is any further hindrance to allowance of the pending claims, Applicants invite the Examiner to contact the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: 4/28/2006

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